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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,881	04/16/2002	Mohammad R Marzabadi	57746-A-PCT-US/JPW/FHB	8075

7590 12/24/2003

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EXAMINER	
ANDERSON, REBECCA L	
ART UNIT	PAPER NUMBER
1626	

DATE MAILED: 12/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/019,881	MARZABADI ET AL.	
	Examiner	Art Unit	
	Rebecca L Anderson	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 September 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *47-52* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *47-52* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *2 IDS's*.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claims 47-52 are currently pending in the instant application and are rejected.

Response to Amendment

Applicants amendment filed 16 September 2003 cancelled claims 1, 15, 22 and 43-46, and therefore has overcome the 35 USC 101 rejections of these claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

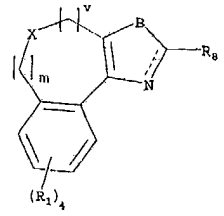
Claims 47-52 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In *In re Wands*, 8 USPQ2d 1400 (1988), factors to be considered in determining whether a disclosure meets the enablement requirement of 35 U.S.C. § 112, first paragraph, have been described. They are:

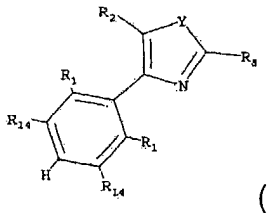
1. the nature of the invention,
2. the state of the art,
3. the predictability or lack thereof in the art,
4. the amount of direction or guidance present,
5. the presence or absence of working examples,
6. the breadth of the claims,
7. the quantity of experimentation needed, and
8. the level of the skill in the art.

The nature of the invention

In the instant case, applicants are claiming a method of treating a subject suffering from an abnormality wherein the abnormality is alleviated by decreasing the activity of a human Y5 receptor comprising administering to the subject a therapeutically effective amount of a compound having the following structures:



(claims 47 and 51) or



(claim 49) or a pharmaceutically acceptable salt thereof to the subject, thereby alleviating the abnormality, wherein the abnormality is an eating disorder, obesity, bulimia nervosa, a sexual disorder, a reproductive disorder, depression, an epileptic seizure, hypertension, cerebral hemorrhage, congestive heart failure, or a sleep disturbance (claims 48, 50, 52).

The state of the art and the predictability or lack thereof in the art

The nature of pharmaceutical arts is that it involves screening *in vitro* and *in vivo* to determine which compounds exhibit the desired pharmacological activities, i.e. treating each specific disease. There is no predictability even in view of the seemingly high level of skill in the art. The existence of these obstacles establishes that the contemporary knowledge in the art would prevent one of ordinary skill in the art from accepting any therapeutic regimen on its face.

The instant claimed invention is highly unpredictable as discussed below:

It is noted that the pharmaceutical art is unpredictable, requiring each embodiment to be individually assessed for physiological activity. In re Fisher, 427 F.2d 833, 166 USPQ (CCPA 1970) indicates that the more unpredictable an area is, the more specific enablement is necessary in order to satisfy the statute. In the instant case, the instant claimed invention is highly unpredictable since one skilled in the art would recognize that in regards to therapeutic effects on specific diseases, whether or not the disease is effected by the decreased activity (antagonism) of the Y5 receptor, would make a difference.

According to Turnbull et al., in regards to appetite control and the treatment of obesity, the selective antagonism of the NPY Y5 receptor does not have a major effect on feeding in rats and that NPY Y5 receptor is not a major physiological regulator of feeding in rats (page 2447). Turnbull et al. also discloses that negative results in human genetic studies have also been found (page 2446). Furthermore, it cannot be assumed that demonstrated in vitro pharmacology and in vivo hypophagic effects share a "cause-effect relationship (page 2447). Also on page 2447, Turnbull et al. discloses that the tested NPY5RA-972 potently antagonizes NPY Y5 receptors in the brain but fails to affect feeding in a variety of rat feeding models.

Hence, in the absence of a showing of correlation between the diseases listed in the specification and the instant claims and the decreased activity of the Y5 receptor, one of skill in the art is unable to fully predict possible results from the administration of the instant compounds due to the unpredictability of the role of the decreased activity of

the Y5 receptor and the diseases (such as obesity) listed in the specification and the claims.

The amount of direction or guidance present and the presence or absence of working examples

The only direction and guidance present in the specification is the use of the compounds shown above to decrease the activity of the Y5 receptor (pages 194-217). The specification is short any data in regards to the treatment of any of the diseases listed in the specification and in the claims, for example, there is no data or results from animal testing, i.e. rat feeding tests. There is no correlation shown between the decrease activity of the Y5 receptor and the diseases mentioned in the specification and the claims, i.e. the specification is silent and fails to provide guidance as to how the decreased activity of the Y5 receptor can treat the diseases as found in the instant application.

The breadth of the claims

The breadth of the claims is the treatment of any disease that can be treated by the decrease of the activity of a human Y5 receptor (described in the specification and claims as, for example, obesity) with the compounds shown above.

The quantity of experimentation needed

The quantity of experimentation needed is undue experimentation. One of skill in the art would need to determine what diseases out of the claimed diseases would be benefited by the decreased activity of the Y5 receptor and would furthermore then have to determine which of the claimed compounds, if any, would provide treatment of the disease.

The level of the skill in the art

The level of skill in the art is high. However, due to the unpredictability in the pharmaceutical art, it is noted that each embodiment of the invention is required to be individually assessed for physiological activity by in vitro and in vivo screening to determine which compounds exhibit the desired pharmacological activity and which diseases would benefit from this activity, i.e. it needs to be shown what compounds are capable of decreasing the activity of the Y5 receptor and which diseases are effected by a decreased activity of the Y5 receptor and are treatable by the administration of a antagonist of the Y5 receptor.

Thus, the specification fails to provide sufficient support of the broad treatment of diseases alleviated by decreasing the activity of a human Y5 receptor. As a result necessitating one of skill to perform an exhaustive search for which diseases can be treated by what compounds in order to practice the claimed invention.

Genentech Inc. v. Novo Nordisk A/S (CA FC) 42 USPQ2d 1001, states that "a patent is not a hunting license. It is not a reward for search, but compensation for its successful conclusion" and "[p]atent protection is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable".

Therefore, in view of the Wands factors and In re Fisher (CCPA 1970) discussed above, to practice the claimed invention herein, a person of skill in the art would have to engage in undue experimentation to test which diseases can be treated by the compounds encompassed in the instant claims, with no assurance of success.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (703) 605-1157. Mrs. Anderson can normally be reached Monday through Friday 7:00AM to 3:30PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph McKane, can be reached at (703) 308-4537.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone numbers are (703) 308-1235 and (703) 308-0196.

A facsimile center has been established. The hours of operation are Monday through Friday, 8:45AM to 4:45PM. The telecopier number for accessing the facsimile machine is (703) 872-9306.

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